

REMARKS

Claims 1-4, 6-11, 13-18, 20 and 21 are pending in the above-identified application. Claims 1-4, 6-11, 13-18, 20 and 21 were rejected. With this Amendment, independent claims 1, 8, and 15 were amended and claims 2-4, 6, 9-11, 13, 16-18, and 20 were canceled. Accordingly, claims 1, 7, 8, 14, 15, and 21 are at issue in the above-identified application.

I. 35 U.S.C. §102 Anticipation Rejection of Claims

Currently pending claims 1, 8, and 15 were rejected under 35 U.S.C §102(e) as being anticipated by U.S. Patent No. 6,088,711 (*Fein et al.*) filed on July 1, 1997. Applicants respectfully traverse this rejection and request reconsideration.

“A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently, in a single prior art reference.” MPEP §2131.

Claim 1 now includes the text “wherein the set of styles comprises a paragraph style gallery and a text style gallery.” The Examiner admits “Fein fails to disclose that said set of styles is divided into a first gallery and a second gallery.” See the Office Action dated February 11, 2005, p. 4, paragraph 13. As *Fein et al.* does not anticipate each and every element set forth in claim 1 either expressly or inherently the rejection under 35 U.S.C §102 must fail.

Claims 8, and 15 are not unpatentable over *Fein et al.* for at least the same reasons that claim 1 is not unpatentable over *Fein et al.*

II. 35 U.S.C §103(a) Obviousness Rejection of Claims

Claims 2-4, 9-11, and 16-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Fein et al.* in further view of Microsoft Corporation, Microsoft Word: User's Guide, 1993-1994 Microsoft Corporation, Version 6.0, p. 114 and p. 133 (*Microsoft*). As claims 2-4, 9-11, and 16-18 are cancelled by the amendment, Applicants request the rejection be withdrawn, and the currently amended claims reconsidered. To expedite the examination of the pending claims the Applicants provide the following remarks with respect to *Fein et al.* in view of *Microsoft*.

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP §2143.

The Examiner argues that it would be obvious for one of ordinary skill to use two style galleries in the manner of Microsoft Word in *Fein et al.* To substantiate this claim, the Examiner cites convenience as a motivation for such a combination of references. Applicants respectfully disagree with the Examiner's assertion. The *Microsoft* document reveals several graphic user interfaces that depict multiple means by which a user may alter or be informed about a document's paragraph and/or text styles. Methods and systems in accordance with the Applicant's invention, in one embodiment, address the long felt need to store style attributes for text documents in a compact manner to facilitate their use and manipulation on compact


electronic devices. The *Microsoft* document cited by the Examiner addresses full text documents accessed and manipulated on computing devices with a computing capacity utilizing essentially all of Microsoft Word's attributes. The references are not analogous to methods and systems in accordance with the present invention. Furthermore, a rejection under §103(a) for obviousness cannot be based on an obvious to try analysis but must reside on an obvious to do result. *In re Clinton*, 527 F.2d 1226, 188 USPQ 365 (CCPA 1976). The categorization depicted by *Microsoft* does not provide a reasonable expectation of success for using and/or manipulating a document on a compact or small electronic device. *Fein et al.* in view of *Microsoft* fails to meet the reasonable expectation of success standard as required by §103(a).

III. Conclusion

In view of the above amendments and remarks, Applicant submits that all claims are clearly allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

Respectfully submitted,

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